

PATENT
Docket 23FLC31

REMARKS

Reconsideration of the above identified application is respectfully requested.

The specification has been amended at para. 22 to correct a punctuation error; and at para. 30 to remove the extraneous numeral 5.

Claim 7 has been amended to match the antecedent support for the recited keyhole slot.

Applicant notes the substantial breadth of interpretation of Applicant's claims being proffered by the examiner, which correspondingly enlarges claim scope in later infringement analysis of the file wrapper. However, the examiner has failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

Applicant traverses the rejection of claims 1-4 under Section 103(a) over Kopp.

MPEP 706.02(j) provides the basic requirements which must be provided by the examiner in establishing prima facie obviousness under 35 U.S.C. 103. Four steps are required of the examiner including: (1) relevant teachings; (2) claim differences; (3) proposed modification of the reference(s) to arrive at the claimed subject matter; and (4) an explanation the proposed modification would have been obvious under Section 103.

The MPEP also requires a showing by the examiner of three basic criteria to establish a prima facie rejection including: first, evidence for the suggestion or modification for modifying or combining references; second, a reasonable expectation of success; and finally, the reference(s) must teach or suggest all the claim limitations, and cannot be based on applicant's own disclosure.

Citing Ex Parte Clapp, the MPEP places the burden of proof on the examiner to provide evidence to support the conclusion of obviousness either from the references which

PATENT
Docket 23FLC31

must expressly or impliedly suggest the claimed invention, or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

It is the examiner who must meet this initial burden by applying specific evidence; and clearly the examiner has not met this burden with the incorrect interpretation of Kopp, and the attempt to use the Harza case without factual, logical, or legal nexus to the claims being rejected.

Furthermore, the examiner has failed to meet the stringent "legal motivation" requirements of MPEP ch. 2100, and has failed to consider the claims in the whole, or the applied reference(s) in the whole.

The examiner admits the fundamental shortcoming of Kopp in failing to show "two rubber bands," and fails to afford any weight to the disparate "one rubber band" thereof.

Claim 1 recites an elastic lash 34 including a pair of annular rubber bands 36,38 joined together at a knot 40 therebetween.

This is in stark contrast with the resilient band 5 of Kopp which is clearly disclosed as a **single-strand** band with knots at both ends for retention. Clearly, Kopp fails to disclose or suggest even a single annular band as introduced in claim 1.

Why? Because the construction and operation of the toy gun in Kopp is quite different than that recited in Applicant's claims, and the examiner has not shown otherwise.

The examiner then attempts to use the expedient of "given one rubber band, it would have been obvious to employ two for multiplied effect," citing *In re Harza*.

But, what does this mean? And, how is this relevant to the operation of the toy gun in Kopp, or the construction or operation of Applicant's different insect swatter?

How is it even possible to use two bands 5 in Kopp. Note, the one band disclosed has a knot at both ends, so how

PATENT
Docket 23FLC31

would two bands 5 be configured or used?

What is the "multiplied effect" the examiner has in mind? Two bands 5 side-by-side along the stock 2? In this way, the two knots 6 would "multiply the effect" of striking the insect?

But, how is this relevant to claim 1 in which the bands are both annular, and joined together at a knot therebetween? What is the "multiplied effect" of that combination?

It is clear that the examiner has not evaluated any of Applicant's claims in the whole, or the applied reference in the whole, and uses the expedient of Harza in an unwarranted rejection of the claims.

What does Harza hold?

Harza is cited in the MPEP at 2144.04 under the caption of "duplication of parts." But, the examiner has failed to establish any nexus between the facts and holdings of Harza, and the specific combinations recited in Applicant's claims, and the disparate configuration of Kopp.

The relevant facts in Harza were a water seal web with ribs to seal the joints between concrete pours. The applied art included a water stop in the shape of a plus sign (+), with the court holding that duplication of the plus sign seal was a mere duplication of parts having "no patentable significance, unless a new and unexpected result is produced."

The examiner's mere duplication of the single-strand band 5 with end knots lacks any explanation as to how that duplication would have been effected; lacks any explanation of the difference in single-strand band 5 versus annular band 34 of the claims; and fails ab initio to meet the factual and legal bases of Harza for mere duplication of parts.

Does Applicant's claim 1 merely recite two single strand bands 5 with end knots like in Kopp? No, claim 1 recites much, much more, which the examiner has overlooked in the rush to reject the claims.

The Kopp's band must first be reconfigured from its

PATENT
Docket 23FLC31

single-strand form to annular form. Then the end knots must be removed. Then two of those annular bands must be combined in some manner. And then, the end knots must be returned.

But, the examiner has not explained any of such modification to meet claim 1, and has therefore failed to meet his burden.

Indeed, the examiner has conspicuously overlooked the present improvement invention and the specific problems being solved over the parent patent application introduced in para. 4.

Note the specific problems presented in paras. 7-9 and 52 & 53.

Note the surprising new and unexpected results of the duplex lash as presented in paras. 55, 61-63, 65, 66, and 68-71.

Note, in particular the spring constant/stiffness advantage of two series springs as presented in para. 62 in which the stiffness is halved and the range is doubled.

In this regard, the examiner merely opines that "it would have been obvious to join the rubber bands [of Kopp] together to increase the range of the weapon." But, where is the evidence to support this bald contention? And, why would one skilled in the art want to do this when no such problem is found in Kopp?

How would the two single strand bands 5 of Kopp in fact be joined together as the examiner contends?

Why not place two, or more, single strand bands 5 on the stock 2 in parallel in the form of a multistrand whip?

The examiner's rejection is classic hindsight.

Harza does not support the examiner's bald contention, and, to the contrary, would appear to teach away from Applicant's claims which enjoy the special operation of in-series annular bands.

Note, the examiner must not only change the form of the single-strand band 5 of Kopp into not just a double strand, but an annular band as recited in claim 1; and then must also

PATENT
Docket 23FLC31

double that annular strand in the hindsight attempt to duplicate Applicant's claim 1 combination.

The changes required are quite profound, and the examiner has failed to meet the stringent requirements of the MPEP in crafting the rejection.

The examiner's contention that Kopp "shows all the method steps of 2 and 4" is erroneous, and fails to afford due weight to the fundamental differences therebetween, and to the differences over Kopp.

Method claim 2 recites stretching a pair of rubber bands on the rod to place the knot mediate the rod for the advantages described in the specification.

Kopp expressly teaches stretching the band 5 so that the end knot 6 is seated in recess 8, which is clearly not mediate the stock 2, but at the proximal end. This teaches away.

Kopp also teaches the use of a single-strand band 5, not an annular band, and it does not appear possible that an annular band could even function in the toy gun of Kopp. See *In re Gordon et al.*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) on inoperable combinations.

Claim 3 introduces the latch 20 which latches the distal end of the lash in the form of the annular band.

In Kopp, the knot 6 is seated in the recess 8, and it does not appear even possible that that recess 8 could latch an annular band lacking any knot 6 of the type expressly disclosed by Kopp.

Method claim 4 also stretches the double band lash to place the knot 40 mediate the rod in a configuration that does not appear possible in Kopp, and the examiner has not shown otherwise in his bald contention of "all the method steps."

Claim 3 is clearly written in the means-plus-function form of Section 112, para. 6, and correspondingly described in the specification.

Accordingly, withdrawal of the rejection of claims 1-4

PATENT
Docket 23FLC31

under Section 103(a) over Kopp is warranted and is requested.

Applicant traverses the rejection of claims 5-9 under Section 103(a) over Kopp and Watkins.

The examiner compounds the errors of rejection, firstly by incorporating the fundamental errors associated with the rejection of claims 1-4, and secondly failing to afford due weight to express claim language, not only in these claims, but now also in claims 5-9 dependent therefrom.

Furthermore, the examiner's hindsight reconstruction is transparent: selectively choosing features of the disparate references without regard to the express teachings thereof or the fundamental differences found in these references.

In Kopp, a single-strand band 5 is disclosed, and cooperates in a specific manner using the end-knot 6 in the recess 8.

In Watkins, a quite different rubber band 14 is disclosed, and cooperates with a leather loop 16 secured to the end thereof by string or wire 37, which in turn is retained on pin 18. The purpose of the leather loop 16 is to hurl the projectile 20. And, the rubber band 14 must, therefore, be large and strong, as clearly shown in the figures.

The examiner must necessarily disregard these fundamental teachings of the two disparate references in his rush to reject the present claims, using Watkins quite apparently for handle 12 disclosed therein in attempting to match the gun handgrip recited in claim 5, without regard to the basic teachings of Watkins, which clearly teach away from any combination with Kopp, not the converse.

The examiner even erroneously contends that Watkins shows "a latch 18 pivotally joined to the handgrip," when there appears to be no evidentiary support for this. See col. 3, ll. 10 & 53 which expressly teaches that the pin is withdrawn downwardly or vertically, and how can such translation movement possibly be interpreted as being pivotal?

PATENT
Docket 23FLC31

Note further, that Kopp discloses a single-strand band 5; and Watkins discloses a single rubber band 14. So, how is it even possible to use two bands 5 or two bands 14 in either structures of Kopp and Watkins?

The band 5 of Kopp is thin, and knotted.

The band 14 of Watkins is fat, and supports the leather loop 16 tied thereto.

So, where is any evidence or teaching in the two references being applied that two bands could in fact be used for any practical benefit; and how should those two bands be used without destroying the original operation of these disparate references.

The errors of the examiner's rejections merely compound as the examiner advances.

It is noted that the same examiner prosecuted the parent application, which is still pending after ten years. And, the same examiner did not allow one claim in that parent application; and now continues to reject each and every claim of this application, without regard to the new problems uncovered, or the new solutions being presented in this application.

This Applicant now politely asks this examiner with all due deference and respect, if he would please, please reconsider this application on its own, new, merits, and try to more objectively evaluate the new claims, and these remarks in traverse of the new rejections, and possibly find claims allowable?

Ten years, two appeals to the Board of Patent Appeals and Interference, and the appeal to the Federal Circuit, are much too much effort to repeat in the present application.

For some reason the examiner has been unable to allow any claims in both of these applications, and it took two appeals to find the allowable claims. Could we not now short circuit that appeal process, and finally afford some weight to the patentability of the present claims, and their considerable improvement over the parent application, as well

PATENT
Docket 23FLC31

as over the same references now being (re)applied?

It is noted that all of the references of record were submitted by the Applicant, and the examiner has failed to uncover any new references in the present application.

The art of record has been well explored now by two Boards of Appeal and the Federal Circuit, and that art includes disparate references notwithstanding the apparent simple nature of the elastic band operations thereof.

The examiner is duty bound under the MPEP to evaluate claims in their whole, including the specific problems being solved and the new solutions therefor.

The examiner is also duty bound to evaluate the references in the whole, and the problems therein to determine what combination thereof would have been obvious to one skilled in the art under the guidelines of MPEP ch. 2100.

If this is done objectively in accordance with the applicable provisions of the MPEP, Applicant is certain that the examiner should now find the allowability of the claims of record, especially when considering that two Boards of Appeal have found allowable the even simpler claims in the parent application, which the present examiner refused to allow.

As indicated above, the differences between claim 5 and the applied references are substantial and fundamental, and the examiner has failed to afford due weight thereto, and instead has looked at apparent similarities only.

The examiner's mere contention to combine the two references lacks specificity of what that combination should entail; how any such combination would even be possible; and the proffered "purpose of providing easier cocking" is a classic hindsight conclusion, neither legal motivation nor based on any identified evidence.

Easier cocking? How?

Kopp requires a recess 8 to retain the knot 6.

Watkins requires a pin 18 to retain the leather loop 16.

The differences could not be greater; so where is any

PATENT
Docket 23FLC31

logical basis or evidence to support the bald contention of "easier cocking?" Where is the teaching of any problem requiring any "easier cocking?"

The hindsight in this contention by the examiner is quite conspicuous, and divorced of logic under the facts of the two references being applied in some unexplained combination of disparate elements.

The examiner's contentions regarding method claims 6 and 8 merely paraphrase Applicant's claims without regard to the fundamental differences of structure and method.

Method claim 6 requires a pair of bands 36,38 stretched to place the knot 40 mediate the rod. In neither Kopp nor Watkins is there any similarity or teaching of two bands 5 or two bands 14 having an intermediate knot configured or disposed in the manner recited in claim 6.

Kopp requires the knot 6 in the recess 8; and Watkins requires the leather loop 16 around the pin 18. Neither configuration meets the requirements of claim 6, and the examiner has not shown otherwise.

The double-band lash recited in Applicant's claims is fundamentally different than the single bands disclosed in Kopp and Watkins; and the latching method is corresponding quite different; and the method of use is therefore quite different, notwithstanding the examiner's unsupported contention to the contrary.

The examiner has failed to afford due weight to claim 7, and merely contends that "it would have been obvious to employ two rubber bands for the same reasons stated above." What were those reasons?

Harza? But, the examiner has failed to establish any basis to apply the facts or holdings of Harza to claim 7; and has also failed to show how two bands would be a mere duplication of parts.

How would it be even possible to employ two bands 5 in Kopp or two bands 14 in Watkins?

The fundamental failures of Kopp and Harza have been

PATENT
Docket 23FLC31

addressed above.

In Watkins, a single band 14 is attached by the string/wire 37 to the leather loop 16. Would one skilled in the art replace either the band 14 or the loop 16, or both, with another band 14 or loop 16, or both, in accordance with the examiner's proposed use of Harza?

Where is the duplication of parts in Watkins, and what to do with Kopp?

Should Watkins now use two bands 14 with a single leather loop 16? How? In parallel? In series? In what other configuration?

Should Watkins now use two leather loops 16? Where is the duplication of parts? And, how would those duplicate parts be combined with the knot 6 and recess 8 of Kopp, or with the pin 18 of Watkins?

The examiner's mere contentions are conspicuous for their simplicity, and lack of due deference or weight to the express teachings of the applied references. The hindsight reconstruction is equally transparent, because that hindsight reconstruction lacks specificity, and is not based on evidence, nor problem-solving in either of the two references, and lacks legal motivation mandated by the MPEP.

Method claim 8 has been grouped by the examiner with method claim 6, which depend from different claims, and are therefore themselves quite different, which differences have not been afforded any weight by the examiner in the continued rush to reject (all) the claims.

Claim 8 includes two elastic bands 36,38 in which the second loop 18b is latched around the latch, with the knot 40 being placed mediate the rod. Claim 8 also recites the keyhole slot 30 in which is retained the first loop 18a.

The examiner merely opines that Watkins shows a keyhole slot 34, etc., but the examiner has failed to afford any weight to the different features recited in method claim 8, and the different operation thereof. General similarities may exist, but claims are entitled to patentable weight, not

PATENT
Docket 23FLC31

for the similarities, but for the differences.

Although Watkins shows a keyhole slot, Kopp does not.

Kopp discloses the knot 6 in the recess 8, and Watkins does not. Instead, Watkins discloses the leather loop 16 around the pin 18.

So, where is the evidence to mix and match the disparate features of these two references in any manner implied, but not explained, by the examiner?

The examiner's bald contentions regarding these claims are not supported by the references, and fail to afford any weight, let alone, due weight to the claim language.

And, and quite significantly on the substantial benefits of using the two recited bands joined together by the intermediate knot 40, the examiner rests the entirety of the rejections on the Harza case dealing with the mere duplication of parts; yet the examiner has failed to, and cannot, show any nexus between the facts of Harza and the facts of Kopp, Watkins, or Applicant's claims.

The examiner has also failed in this regard to show how it would even be possible to merely duplicate any parts of Kopp and Watkins. Duplicate the single strand band 5 of Kopp? How? Why? And, what about the end knots of that band?

Duplicate the rubber band 14 of Watkins? How? Why?
And, what about the leather loop 16? Duplicate it?

Claim 9 recites the upward extension of the latch 20; the downward direction of the slot 30; and the position of the knot 40 atop the rod.

There is no slot in Kopp, see item 4.

The slot 34 in Watkins extends upwardly, not downwardly as the examiner baldly contends.

How should these disparate teachings be combined? The examiner has not explained this in his rush to reject.

And, the knot 6 in Kopp is located in the recess 8, not mediate the rod. The string/wire 37 in Watkins is located at the end of the rubber band 14, and the loop 16 is not a

PATENT
Docket 23FLC31

rubber band looped around the pin 18.

The differences in claims 5-9 are profound over the disparate references being applied, and the examiner has failed to afford due weight thereto.

Accordingly, withdrawal of the rejection of claims 5-9 under Section 103(a) over Kopp and Watkins is warranted and is requested.

Applicant traverses the rejection of claims 10-16 under Section 103(a) over Kopp, Watkins, and Stone.

Yet again, the fundamental failures of Kopp and Watkins have been addressed above, and these errors are now further compounded by the examiner's introduction of a third, yet additionally disparate reference Stone.

The examiner recites certain features of Stone, but conspicuously overlooks the fundamental teaching of Stone that the rubber band is fired away from the barrel 10. Clearly, this basic teaching teaches away from any combination of the three disparate references.

Also equally clear, is the examiner's insidious use of impermissible hindsight in its most classic form: i.e. selecting from the three references only certain features to the exclusion of other features, and without regard to the problems being solved therein.

No patent application could pass this type of hindsight examination. The examiner did the same thing in the parent application, and now continues in this application. Yet, in the parent application two Boards of Appeal twice reversed the examiner's two different sets of rejections of all the claims to find allowable subject matter.

What the examiner clearly overlooks in his attempt to use the latch 30 of Stone, is the fundamentally different construction of Kopp and Watkins.

How is it even possible to incorporate the latch 30 of Stone in Kopp? Substitute the recess 8? Why? This would require a wholesale change in the design of Kopp.

How is it even possible to incorporate the latch 30 of

PATENT
Docket 23FLC31

Stone in Watkins? Substitute the pin 18? Why? This would require a wholesale change in the design of Watkins.

The examiner merely opines that "one latch is being substituted for another," yet the examiner has not shown how this is even possible given the different configurations of the band 5 of Kopp, and band 14 of Watkins; and the different configurations of the three types of guns.

The examiner's bald contention that "the function is the same" is clearly erroneous. Even a superficial review of the teachings of Kopp and Watkins clearly shows to the contrary, and two patents were nevertheless issued by the USPTO.

In Kopp, the recess seats the knot 6 to fire the band.

In Watkins, the pin 18 holds the loop 16 to fire the projectile 20.

And in Stone, the hammer bevel 30 holds the band 33 to hurl it away from the barrel 10.

Indeed, it is not seen how either Kopp or Watkins could operate with the latch 30 of Stone since the constructions are quite different, and would require wholesale reconstruction in Kopp and Watkins to meet the examiner's proposed combination.

The examiner merely contends that "no stated problem is solved," which is itself erroneous; and the examiner, himself, fails to identify any "stated problem" in either Kopp, or Watkins, or Stone for which the examiner's proffered "solution" would have any relevance to any of the claims, including, fundamentally, independent claim 1 itself.

Stated problem? Applicant's specification is replete with expressly stated problems, none of which has been addressed by the examiner in his rush to reject.

Many paragraphs containing these problems have been listed above.

The double bands introduced in claim 1 specifically address many stated problems, apparently overlooked by the examiner in his rush to reject.

For claim 10, the examiner for the first time addresses

PATENT
Docket 23FLC31

"problems," but not in evaluating Applicant's claims in the whole, and not for affording any weight to Applicant's claims; but, to the contrary, in attempting to apply the disparate teachings of the third reference Stone to the first two references Kopp and Watkins being applied in series, in fabricating a rejection, clearly in hindsight.

The latch 20 is introduced at para. 30, and the construction thereof is disclosed in detail, including its performance and the problems it overcomes.

For example, the latch must be configured to retain the loop, allow it to slide off, and allow spontaneous firing of the double-band lash.

The details recited in claim 10 are fundamentally different than the firing mechanisms in Kopp, Watkins, and Stone that the examiner has no basis to challenge the efficacy of those details in claim 10, when that latch cooperates with the specifically recited lash, which is quite unlike those disclosed in the applied references.

The examiner's failure to afford any weight to any claim is further evidenced in his remarks regarding claim 11. Notwithstanding the examiner's own admission that the three references being applied do not "show a thumb grip," the examiner routinely attempts to apply "Judicial Notice that thumb grips are old...."

This expedient by the examiner is not supported by the stringent requirements of the MPEP; nor does it appear to have even a colorable basis.

On page 9 of the 9/20/2001 decision on Appeal No. 2000-2033 in the parent application, the Board of Appeals found substantially the same argument presented by the same examiner for substantially the same features being introduced in claim 11 of that parent application to be untenable, and lacking of evidence.

The examiner's attempt to repeat that previous ground of rejection is equally defective here, and further evidence of the failure of the examiner to evaluate Applicant's claims in

PATENT
Docket 23FLC31

the whole, and the failure to afford due weight to the express combinations thereof, which poisons the examiner's rejections of all the claims.

The examiner merely opines that "it would have been obvious to employ a thumb grip to make cocking easier."

How would this be done in the three references?

Why?

In Kopp, the knot 6 is retained in the recess 8. How would a thumb grip make any cocking easier in this reference?

How would Kopp be modified to include a thumb grip? And, where is the evidence to support the introduction of a thumb grip?

In Watkins, the loop 16 is held on the pin 18, and that pin 18 extends up from handle 12 which has the two operative gaps 24,26. How would a thumb grip make any cocking easier in this reference? How would Watkins be modified to include a thumb grip; which does not appear even possible? And, where is the evidence to support the introduction of a thumb grip?

In Stone, the band 33 is held on the hammer bevel 30, and that hammer adjoins the trigger 22. How would a thumb grip make any cocking easier in this reference? How would Watkins be modified to include a thumb grip, when the bevel 30 already extends aft? And, where is the evidence to support the introduction of a thumb grip?

The examiner has clearly prejudged this application, as well as the parent application, and is using the benefit of hindsight in his role as examiner to deny Applicant's claims a fair evaluation.

If the examiner refuses to recognize the allowable subject matter of the features being introduced in claim 11, which allowability is clearly supported by the previous decision by the Board of Appeals, how then can the examiner's rejections of the other claims be considered fair and devoid of impermissible hindsight?

Not one claim has this examiner indicated as containing

PATENT
Docket 23FLC31

allowable subject matter. Not one claim; and without regard to the ten year odyssey in the parent application, which is now fated to be repeated?

Claim 12 recites the spring 26 in a specific combination. Yet, the examiner attempts to use the spring 27 of Stone without any regard to the different configuration thereof, and without regard to the different configurations of Kopp and Watkins: clearly evidence of impermissible hindsight.

Where and how would the spring 27 of Stone be introduced in Kopp, and for what benefit?

Where and how would the spring 27 of Stone be introduced in Watkins, and for what benefit?

The differences in configurations of these references is outstanding, yet the examiner in a blind rush to reject clearly must overlook any and all such differences in the rote rejection of claim by claim, as conspicuously evident in the remarks of record.

The examiner's rejection of method claim 13 lacks any showing of "Kopp as modified by Watkins."

None of these three references discloses or suggests the use of two annular bands, with a knot therebetween which is mediate the rod during the firing process.

"Envisions the method steps" the examiner baldly opines?

In Kopp, the knot 6 is released from the recess 8.

In Watkins, the projectile 20 is hurled when the leather loop 16 is released.

And, in Stone the entire band 33 itself is hurled away when fired.

No, these references clearly do not "envision the method steps" of claim 13; but to the contrary, these references teach away from claim 13 in view of their quite different construction, and quite different operation; none of which the examiner recognizes in the rush to reject claim by claim, notwithstanding the continued complexity of those claims as disparate features are added in sequence.

PATENT
Docket 23FLC31

Regarding the examiner's rejection of claim 14, the examiner has pointed to no evidence in any one of the three references to support the specific combination recited therein. "Envision" is clearly not the same as evidence, and Applicant requests that the examiner cite specific evidence in these references to support the rejection under Section 103.

Regarding claim 16, Applicant requests that the examiner provide the source of his "definition of an elastic material [being] one that stretches three times its original length."

This definition is clearly rote examiner argument in its most conspicuous form, and fails to recognize not only the common knowledge, of which the examiner may take Judicial Notice, but also Applicant's express disclosure of the different capabilities of differently configured rubber bands.

A short, fat rubber band may not be stretched past its own length, let alone multiple (3x) lengths.

A long, thin rubber band may be stretched more.

And, differently configured rubber bands are found in between.

The three references Kopp, Watkins, and Stone are configured and function differently than Applicant's claim 15, and the configurations of the different bands thereof are necessarily different, and the examiner has not shown otherwise.

The examiner's contentions regarding claim 16 that "the function is the same and no stated problem is solved," is yet additional evidence that the examiner has failed to fully evaluate Applicant's specification.

Applicant's specification indeed presents and solves various problems, as indicated in the above-listed paragraphs; for which the examiner baldly fails to afford any weight thereto, let alone due weight.

The examiner has failed to recognize any one of those problems listed in the specification, and solved by

PATENT
Docket 23FLC31

Applicant's recited claims; and has failed to challenge the sufficiency or relevancy thereof in his blind rush to reject.

How is it possible that the examiner could have read and evaluated Applicant's specification in the whole, yet still make unsupported and unqualified statements that "no stated problem is [being] solved?"

Accordingly, withdrawal of the rejection of claims 10-16 under Section 103(a) over Kopp, Watkins, and Stone is warranted and is requested.

In view of the examiner's exceptionally broad interpretation of the original claims; and in view of the significant differences over the improved insect swatter over the art of record, Applicant has chosen to add claims 17-20.

Independent claim 17 recites the insect swatter including its elongate rod and elastic lash configured as a figure-eight with a knot between the two loops, which are knotless. See paras. 19, 57, and 60 for support in the specification.

As indicated above, none of the applied references discloses or suggests a figure-eight configured band in the combination of this claim.

Furthermore, the knotless feature of the two loops is being added to specifically preclude knots at both loops to further distinguish over the Kopp reference in response to the second decision by the Board of Appeal in the parent application, at the bottom of page 7 thereof.

Claim 18 recites the handgrip 14, latch 20, and trigger from claims 3 and 5, and as described at paras. 20, 30, and 32.

This combination of features is neither disclosed nor suggested by the applied references which require different single bands; different latching and triggering mechanisms; and which lack any cooperation with the figure eight band being recited.

Claim 19 recites the two annular band species, joined in series with a collective spring rate equal to the reciprocal

PATENT
Docket 23FLC31

of the sum of reciprocals of the individual spring rates as disclosed at paras. 54, 62, and 63.

This combination provides unexpected benefits in increasing stretch capability with reduced stiffness providing enhanced swatting range and efficacy.

Since the applied references use single bands, with an end knot in Kopp; an end leather loop in Watkins; and a projectile band in Stone, there is no disclosure or suggestion in these disparate references to utilize series springs for any advantage.

Claim 20 recites the identical rubber bands disclosed at para. 56 of the specification for the advantages attributable thereto.

Kopp requires a single specialty band with end knots having different configuration, operation, and cost.

Watkins requires both a rubber band and a leather loop attached together using the string/wire in a specific combination for hurling the projectile, which is more complex than that recited in claim 20, functions differently, and would clearly cost more to produce.

And in Stone, the single band is hurled away as the projectile itself in a configuration have no disclosed relevance to Kopp and Watkins, notwithstanding the examiner's attempted combination of selected features thereof without regard to the fundamental features and teachings thereof.

Accordingly, added claims 17-20 are patentably distinguishable over the references of record.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record, and update the search, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations

PATENT
Docket: 23FLC31

thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in *Ex parte Schriker*, 56 USPQ2d 1723 (B.P.A.I. 2000).

The Board of Appeals in the second appeal of the parent application cited *In re Borkowski* to permit "the flexibility to reconsider and correct prior decisions that [the Patent Office] may find to have been in error."

This flexibility was, of course, at the considerable expense of the Applicant when the present examiner re-opened prosecution using the same references of record following the first full reversal by the first Board, which led to the second appeal, also decided in Applicant's favor.

Let's not repeat re-application of the references of record in *de novo* office actions. Should the examiner not now find the claims in condition for allowance, then the examiner is expressly requested hereby to ensure that all possible combinations of the various references, and all possible rejections under the guidelines of the MPEP have been made so that the next appeal is complete on all possible issues.

There should be no excuse for the two appeals in the parent application; the examiner's previous errors have now been documented in the substantial record of the parent application, and in the two decisions of the Board of Appeal.

The continuation of errors made by the examiner have now been addressed above; and the claims should now be in condition for allowance, or for appeal.

It is now the examiner's prerogative to either allow the application to pass to issue, or ensure that any final rejection meets the completeness and thorough standard of the Patent Rules, and the MPEP.

Let's not devote again ten years to complete the prosecution of this improvement application, having specific features nowhere disclosed or suggested by any of the applied references.

In view of the above remarks, allowance of all claims 1-

Tuesday, September 28, 2004 8:46 AM

To: RightFax-9306

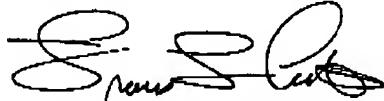
From: Francis L. Conte, Esq., 781-592-4618

Page: 28 of 28

Docket 23FLC31

20 over the art of record is warranted and is requested.

Respectfully submitted,



Francis L. Conte

Date: 28 Sep 2004

6 Puritan Avenue
Swampscott, MA 01907
Tel: 781-592-9077
Fax: 781-592-4618